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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,856	07/25/2001	David H. Mack	003848.00091	4786

7590 09/15/2004

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EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/911,856

Applicant(s)

MACK, DAVID H.

Examiner

Channing S Mahatan

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 05 August 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☒ The drawing correction filed on 02 May 2003 is a) ☒ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

10. ☒ Other: See Continuation Sheet

Marianne P. Allen  
MARIANNE P. ALLEN  
PRIMARY EXAMINER

9/13/04

44163)

C. Mahatan  
September 13, 2004

Continuation of 5. does NOT place the application in condition for allowance because: the rejections of claims 1-9, 106, and 107 are maintained for reasons of record (See below box 10).

Continuation of 10. Other: Claims 10-105 have been cancelled. Applicants argue the specification provides detailed disclosure for carrying out the claimed process; citing pages 39-40 of the specification. This is found unpersuasive, wherein the specification fails to describe the parameters/criterias applicable to the problem at hand which is the analysis of the gene cluster map to thereby generate gene network causal models. As previously stated "An individual skilled in the art would not have been informed as to what to do or how to adapt programs (i.e. general) known in the art unless some type of specific procedures are set forth (i.e. specified parameters and assumptions) for gene network causal models". For instance, after the generation of said cluster map what are the parameters and assumptions which are to be utilized in the analysis of said cluster map to generate gene network causal models that define regulatory relationships among said genes. While it is agreed that LISREAL is a general approach the amount experimentation is disagreed with. Thus, one practicing the method as claimed would have to use his or her own inventive skill or ingenuity beyond that to be expected of one of ordinary skill in the art to adapt the known cluster analysis techniques to this particular problem; an invitation to perform undue experimentation to analyze the generated cluster map to further generate a gene network causal model. Applicants are directed to *Fields Wilkinson, and Kende v. Conover and Woodward* [170 USPQ 276; How-to-Make Requirement section] which states: "the description must place the invention in the possession of the public as fully as if the art or instrument itself had been practically and publicly employed. In order to accomplish this, it must be so particular and definite that from it alone, without experiment or the exertion of his own inventive skill any person versed in the art to which it appertains could construct and use it." The specification fails to provide one of skill in the art proper guidance to make and/or use the claimed method, computer program device, and computer program carrier. The previous 'Office Actions (mailed 16 July 2003; 05 February 2004; and 20 November 2003) cited Schena et al. and stated that the "refinement of LISREAL would be required to analyze the provided gene expression information to generate gene network causal models. Applicants have asserted "very little experimentation is required to generate a useful analysis" (response filed 05 August 2004, pages 3-4), however, Applicants have not provided the parameters and assumptions applicable to Schena et al. to generate and analyze a cluster map to generate gene network causal models defining regulatory relationships among said genes. Thus, Applicants are requested to provide the parameters and assumptions to be applied to Schena et al. since Applicants appear to assert that such analysis (i.e. parameters and assumptions) can be easily ascertained/performed, wherein the Examiner is unable to perform such a function. Therefore, Applicants' arguments are found unpersuasive and the rejection of claims 1-9, 106, and 107 under 35 U.S.C. 112 1st Paragraph (Lack of Enablement) are maintained for reasons of record.